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EXAMINER

ELLIS, RICHARD L

ART UNIT PAPER NUMBER

2183

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

STATUTE AND REGULATION

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

The Office...may establish regulations, not inconsistent with law, which...
(A) shall govern the conduct of proceedings in the Office.

35 U.S.C. § 41(a) stated in pertinent part on January 1, 2003¹:

(6)(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$320...

(8) For petitions for 1-month extensions of time to take actions required by the Director in an application--

- (A) on filing a first petition, \$110;
- (B) on filing a second petition, \$410; and
- (C) on filing a third petition or subsequent petition, \$930.

35 U.S.C. § 42(d) states:

The Director may refund any fee paid by mistake or any amount paid in excess of that required.

35 U.S.C. § 132(b) states:

The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

35 U.S.C. § 134(a) states:

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

37 CFR 1.17(e) requires a fee:

To request continued examination pursuant to § 1.114:
By a small entity (§ 1.27(a))...\$375.00
By other than a small entity... \$750.00

37 CFR 1.26(a) provides in pertinent part:

The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party

¹ Pursuant to 35 U.S.C. § 41(h)(1), these fees are subject to a 50% reduction for small business concerns, independent inventors or nonprofit organizations. .

desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

37 CFR 1.113 states:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.114 provides in pertinent part:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the

application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

37 CFR 1.181(a) states:

Petition may be taken to the Commissioner:

- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
- (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

OPINION

Petitioners request (1) that the decision of the Group Director, which refused withdrawal of the finality of the Office action of October 1, 2002, be overturned, (2) the finality of the October 1, 2002, Office action in this application be withdrawn (*i.e.*, prosecution be reopened), and (3) the extension of time, Notice of Appeal, and RCE fees paid be refunded.

35 U.S.C. 132(b) and its promulgating regulation 37 CFR 1.114 provide for the continued examination of an application at the request of applicant upon payment of a fee. Since, on July 3, 2003, the RCE had been filed on or after May 29, 2000, but prior to payment of the issue fee or abandonment of the application or the filing of any notice of appeal to the Federal Circuit or the commencement of a civil action; the application had been subjected to close of prosecution and was now under appeal to the Board of Patent Appeals and Interferences, as required by 37 CFR 1.114(b); and a timely submission and fee required by 37 CFR 1.114(c) had been filed; the RCE filed July 3, 2003, was a proper request for continued examination. As such, by operation of 37 CFR 1.114(d), prosecution was reopened herein on July 3, 2003, by applicants' own request (*i.e.*, the finality of the Office action of October 1, 2002, and the Notice Of Appeal of May 1, 2003, were withdrawn.) See 37 CFR 1.114(d).

As to the first two above-enumerated issues for which the Director's intervention is requested *i.e.*, review of the decision of the Group Director which refused to withdraw the finality of the Office action of October 1, 2002, as well as withdrawal of the finality of the Office action of October 1, 2002, these issues are moot due to petitioners' own Request for Continued Examination filed July 3, 2003. Petitioners appear to overlook that the RCE request filed under 35 U.S.C. § 132(b) and 37 CFR 1.114 on August 5,

2002, has reopened prosecution in this application. That is, where, as here, a finally rejected application contains a Notice of Appeal, and is made the subject of a Request for Continued Examination, both the appeal and finality of the outstanding Office action are withdrawn, such that prosecution of the application is reopened. See 37 CFR 1.114(d). Thus, the finality of the Office action of October 1, 2002, has been withdrawn by way of the reopening of prosecution, since the date the Request for Continued Examination was filed by applicants (July 3, 2003). It follows that there is no remaining condition of finality within the meaning of 37 CFR 1.113, of which petitioners complain, to review or withdraw by way of the instant decision. Likewise, the requested review of the Group Director's decision is a moot action, because the involved question of finality is no longer an issue.

It is noted that the basis for petitioners' request(s) for withdrawal of the finality was that the second Office action was silent on "essential elements" of the examiner's prima facie case and otherwise violated non-discretionary requirements. Since inspection of the record which will be before the examiner at the time of the forthcoming office action includes e.g., the arguments presented in the various papers filed subsequent to the final Office action as well as the submission filed with the RCE request on July 3, 2003, the basis for applicants' current and previous petitions is not likely to recur.

As to the request for refund of the fees incurred since the final Office action of October 1, 2003, while petitioners concurrently sought reconsideration of the contested finality and then review on petition of the contested finality, this cannot be granted.² 35 U.S.C. § 42(d) permits a refund of "any fee paid by mistake or any amount paid in excess of that required." Thus, the Patent and Trademark Office (PTO) may refund: (1) a fee paid when no fee is required (a fee paid by mistake); or (2) any fee paid in excess of the amount of fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r Pats. 1943) (the statutory authorization for the refund of fees is applicable only to a mistake relating to fee payment).

However, petitioners have not shown that the fees in question were paid either by mistake or in excess. Petitioners do not assert, and inspection of the record fails to reveal, that the fees in question were paid by mistake. That is, each fee in question was owed at the time it was paid. As such, there is no mistake relating to the payment of each of the fees in question within the meaning of 35 U.S.C. 42(d). See Grady, *supra*. Likewise, petitioners do not assert, and inspection of the record fails to reveal, that any fee in question was paid in excess of the amount owed. Rather, each fee in question was paid in the correct amount. As such, there is no excess fee paid within the meaning of 35 U.S.C. § 42(d) such that a refund is proper.

Indeed, petitioners obtained the very result(s) for which the fees were paid: the pendency of the above-identified application was maintained. To now seek a refund of these fees after the intended result(s) has been obtained constitutes a change in purpose, which does not entitle a party to a refund. See 37 CFR 1.26(a). The patent statute and the rules of practice before the USPTO do not permit an applicant to request and pay for a conditional extension of time fee, a conditional Notice of Appeal fee, or file a conditional request (and fee) for continued examination, and depending on subsequent events, obtain a refund of the fee(s).

² 37 CFR 1.181(f) requires that an applicant continue to prosecute the patentability issues of his application notwithstanding any requested review on petition of a procedural matter.

DECISION

The request to review the decision of the Group Director which refused to withdraw the finality of the Office action of October 1, 2002, as well as the request to withdraw the finality of the Office action of October 1, 2002, are **dismissed as moot** as the Request for Continued Examination filed July 3, 2003, has reopened prosecution and thus removed the finality of the Office action of October 1, 2002.

The request for refund of the extension of time fee, the Notice of Appeal fee, and the RCE fee is **denied**, as these fees were neither paid in error nor in excess.

The USPTO will not further consider or reconsider this matter. This decision may be viewed as a final agency action for purposes of seeking judicial review. See MPEP 1002.02.

This application is being returned to Technology Center 2183 for treatment of the RCE filed July 3, 2003.

Telephone inquiries related to this decision should be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

A handwritten signature in black ink, appearing to read 'Charles Pearson', with a long horizontal line extending to the right.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner for
Patent Examination Policy